

REMARKS

This Amendment, filed concurrently with a Request for Continued Examination (RCE), is a full and timely response to the final Office Action dated January 7, 2003 (Paper No. 5). By this amendment, Applicants seek to set forth claims 3, 4 and 17 in independent form in order to further clarify a scope of the invention sought to be patented by the present application, thereby distinguishing the present application over the applied art. New claims 26-28 are added. Support for these amendments can be found variously throughout the specification, including, for example, original claims 1-4 and 16. Consequently, claims 1 and 16 have been subsequently cancelled without prejudice or disclaimer of the subject matter contained therein. Additionally, claims 2, 5, 6, 21, 22 and 24 have been amended to correctly depend upon allowable base claim 3, claims 23 and 25 have been amended to depend upon allowable base claim 4, and claim 18 has been amended to depend upon allowable base claim 17. No new matter has been added. Further examination and consideration in light of the present amendment and the following remarks are respectfully requested.

Claim Rejections - 35 U.S.C. § 102(b):

In the action, claims 1, 2, 5, 6, 16, 18, 19 and 21-25 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by, or in the alternative, under 35 U.S.C. § 103(a), as being obvious over U.S. Patent No. 5,523,609 to

Fukusho ("Fukusho"). This rejection is respectfully traversed in light of the present amendment.

The present amendment cancels claims 1 and 16, amends claims 2, 5, 6 and 21-25 to depend upon allowable base claim 3, and amends claim 18, upon which claim 19 depends, to depend upon allowable base claim 17. Accordingly, because the rejection of the claims under Fukusho was not applied to allowable base claims 3 and 17, upon which each of the foregoing claims now depend either directly or indirectly, the present rejection is rendered moot. Withdrawal of this rejection is therefore respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a):

Claims 1-6, 16-25 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,621,461 to Higashide ("Higashide") in view of U.S. Patent No. 5,773,859 to Ueno ("Ueno"). This rejection is respectfully traversed in light of the present amendment.

As conceded on page 3 of the Office Action dated August 20, 2002, Higashide fails to teach of a solid-state imaging device possessing a multilayer light-shielding film. The examiner seeks to remedy this deficiency by applying Ueno as allegedly teaching a double layer light-shielding layer made of tungsten. However, as stated in a previous response filed November 20, 2002, Ueno is not prior art under 35 U.S.C. § 103(c).

The Ueno patent is assigned to Sony Corporation ("Sony") and was so assigned when the present application was filed. Under 35 U.S.C. § 103(c) as amended in the American Inventors Protection Act of November 29, 1999, and 37 C.F.R.

§ 1.104(c)(4), a patent cannot be used as basis for a 102(e)/103(a) rejection if two requirements are met. First, the cited patent and the present invention must be assigned to a common owner in assignments that are recorded with the U.S. Patent and Trademark Office. Second, the owner or the owner's legal representative must assert that at the time the invention claimed in the patent application was invented, the invention was assigned to the same assignee that owns the patent.

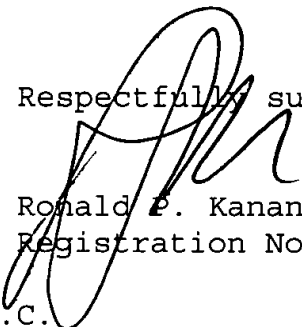
At the time the invention was made, the current inventors were under obligation to assign the invention to Sony, and did in fact assign the invention to Sony by way of the assignment recorded December 28, 1998 on Reel 9687, Frame 0229. The Applicants regret erroneously stating that the present invention was assigned to "Kansai Paint" in the response filed November 20, 2002. The present invention is not assigned to Kansai Paint, but is in fact assigned to Sony. This information can be found in the present application's parent file SON-1408, which has subsequently issued as U.S. Patent No. 6,281,034. Consequently, the Ueno patent is not prior art with respect to the present invention under 35 U.S.C. § 103(c). Accordingly, because Higashide concededly fails to teach each of the limitations recited in the present invention, and further because Ueno is not prior art under 35 U.S.C. § 103(c), a *prima facie* rejection of the claims has not been established, and withdrawal thereof is respectfully requested.

Conclusion:

For at least the foregoing reasons, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the examiner is respectfully requested to pass this application to issue. If the examiner has any comments or suggestions that could place this application in even better form, the examiner is invited to telephone the undersigned attorney at the below-listed number.

Respectfully submitted,

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